

## REMARKS

The present Amendment responds to the Office Action dated March 14, 2008. The Examiner set a shortened statutory period for reply of three (3) months, making the present Amendment due by June 14, 2008, which is a Saturday, such that the present response is timely if filed on Monday, June 16, 2008.

In the Office Action, claims 1, 3, and 4 are pending. The Examiner rejected each of the claims under 35 U.S.C. § 103(a) as being unpatentable over WO 00/05956 to Kim et al. in view of Davies et al. Claims 3 and 4 are additionally rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim et al. in view of U.S. Patent No. 5,981,432 to Hudetz et al. (the "432 Patent"). Applicant respectfully disagrees with the Examiner claim rejections and requests that the Examiner reconsider these rejections based on the following arguments.

At the outset, Applicant notes that the Kim et al. reference was the sole reference used to reject the claims in the previous Office Action. In that Office Action, the Examiner stated that the reference "does not teach the specific synergistically effective compounds or combinations disclosed in claims 1 and 2 (component b))." (emphasis added). In the present Office action, the Examiner further states that the Kim et al. reference does not teach S-metolachlor. The Examiner now cites to Davies et al., stating that the reference discloses the herbicide metolachlor and argues that one of ordinary skill in the art would be motivated to combine the reference's teaching of S-metolachlor with that of Kim et al. to arrive at Applicant's claimed invention.

Applicant again takes the position that the Examiner has not established a *prima facie* case of obviousness. The Examiner's position appears conclusory as it does not set forth a clear understanding of how the teachings of the Davies et al. reference would motivate one of ordinary skill in the art to arrive at the claimed composition. Applicant argues here that the Examiner has improperly supported the § 103(a) rejection of the claims as it appears to lack "an articulated reasoning with some rational underpinning to support the legal conclusion of obviousness", as set forth in Section 2141 (III) of the MPEP. The Examiner appears to argue that because Davies et al. mentions the herbicide metolachlor, one of ordinary skill in the art would recognize that combining S-metolachlor with metamifop would yield a synergistic effect. This alone does not rise to the level of a *prima facie* case of obviousness.

Secondly, a closer look at the Davies et al. reference makes it clear that Davies et al. are concerned with herbicide safeners. More particularly, the reference provides a "critical review" of the understanding of safeners and the mechanisms by which they contribute to herbicide selectivity and resistance. See p. 1043, Introduction. As such, the Davies et al. reference is not concerned

with synergy, or the combination of herbicides to yield a synergistic effect. Accordingly, where is the motivation to arrive at Applicant's invention? Where is the motivation to combine metamifop and S-metolachlor, or even metamifop and metolachlor, the herbicide actually disclosed in Davies et al.? Applicant submits that if one of ordinary skill in the art wanted to combine the teachings of these two references, it is more likely that s/he would arrive at a composition containing an amide compound of formula (1), as disclosed in Kim et al., and a safener disclosed in Davies et al., than arriving at Applicant's claimed invention.

Further, The Examiner does not assert here how the combination of the references cited would form a *synergistic* composition. Applicant highlights that "a synergistically effective amount of S-metolachlor" is an element of this claim. As already acknowledged by the Examiner in the previous Office Action, there is no mention of synergy in the Kim et al. reference. Since Kim et al. are silent as to synergistically increasing the effects of the herbicidal phenoxypropionic acid N-alkyl-N-2-fluorophenyl amides, one of ordinary skill in the art would not be motivated to combine metamifop with a synergistic amount of S-metolachlor. Further, nothing in Davies et al. teaches the synergy of this combination, either expressly or inherently. Accordingly, Applicant believes that the Examiner has failed to establish a *prima facie* case of obviousness here as the combination of the two references cited would not motivate one of ordinary skill in the art to arrive at Applicant's claimed invention.

Turning now to the second rejection under § 103(a), the Examiner argues that one of ordinary skill in the art would be motivated by the '432 Patent to arrive at Applicant's claimed method. Applicant takes the position that there is nothing in the '432 Patent, either express or inherent, that would motivate one of ordinary skill in the art to combine a synergistically effective amount of S-metolachlor to metamifop. The '432 Patent teaches the combination of S-metolachlor with a synergistically effective amount of a substance having the formula  $A-SO_2-NH-E$ . See Col. 1, lns. 45-65. Metamifop does not fit within this general formula.

Secondly, Applicant highlights that the Kim et al. reference does not teach mixing metamifop with any chloroacetanilides, let alone S-metolachlor. As previously asserted, Kim et al. teach a list of mixing partners that are "essential" to the compounds of formula (1). On page 21, Kim et al. teach "[e]specially it is essential" to add one or more agents selected from the group consisting of..." (p. 21, lines 20-21) (emphasis added). One of ordinary skill in the art would understand that these thirty-five (35) agents specifically listed on page 21 are a requirement for the utility of these herbicidal compounds, such as metamifop. Applicant submits that this essential list of agents discourages one of ordinary skill from seeking alternative mixing partners, such as S-metolachlor.

Moreover, since Kim et al. are silent as to synergistically increasing the effects of the herbicidal phenoxypropionic acid N-alkyl-N-2-fluorophenyl amides, one of ordinary skill in the art would not be motivated to stray outside of the essential list of agents to then find a mixing partner, such as S-metolachlor, that would exhibit a synergistic action to the targeted weeds. The combination of the '432 Patent and Kim et al. could only be achieved through hindsight reasoning, which is not permitted in finding obviousness. Accordingly, Applicant respectfully submits that the Examiner has improperly rejected claims 3 and 4 and requests that the rejection be withdrawn.

Based upon the foregoing arguments, Applicant submits that the Examiner's *prima facie* case of obviousness is supported by a general, conclusory statement, and is therefore an improper rejection of the pending claims. In addition, Applicant argues that Kim et al. teach away from the claimed invention because the reference teaches that it is essential to combine the herbicidal compounds of formula (1) with a very specific list of agents, none of which include any chloroacetanilides, let alone S-metolachlor. Finally, Applicant argues that the Kim et al. reference, alone, could not motivate one of ordinary skill in the art to explore mixing partners that would exhibit synergistic action. The requisite motivation to first step outside of the list of essential agents to then combine metamifop and S-metolachlor for the purpose of exceeding the additive effect of those active ingredients on the weeds cannot conceivably be derived from the Kim et al. disclosure without resorting to hindsight reasoning, which is impermissible in establishing a *prima facie* case of obviousness.

Based upon the foregoing then, Applicant submits that the pending claims are in condition for allowance and the Examiner is courteously solicited to pass this application on to allowance. No other fees are believed to be payable at this time. However, the Commissioner is authorized to debit any applicable fees from the deposit account of the undersigned, no 50-1676 in the name of Syngenta Crop Protection, Inc.

Respectfully submitted,

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